APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,645	11/13/2000	Richard C. Fuisz	56915-021	3732

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EXAMINER
EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2004*.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 18-22* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-14 and 18-22* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *13 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some * c)☐ None of:
   1.☐ Certified copies of the priority documents have been received.
   2.☐ Certified copies of the priority documents have been received in Application No. _____.
   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for

reconsideration filed on February 18, 2004. Claims 1-14 and 18-22 are presented for

further examination. Claims 20-22 are new claims.

Specification

Examiner acknowledges that the use or URLs and web addresses is necessary

to the disclosure and has withdrawn the objections to the specification.

Claim Rejections - 35 USC § 101

1.   Examiner has withdrawn the claim rejections under 35 USC §101 because

Applicant's amendments have overcome the rejection.

Claim Rejections - 35 USC § 112

2.   Examiner has withdrawn the claim rejections under 35 USC §112 because

Applicant's amendments have overcome the rejection. However, the following

rejections apply to the new claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new limitation that the "scheme-specific name is only a top-level domain name" was not disclosed in the specification as originally filed. The original specification makes no mention of a "top-level" domain name, and thus does not describe how the system would translate a name into a top-level domain name.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "top-level domain name" is ambiguous as used in the claims. The term is not defined in the specification, and normally refers to the ".com" or ".edu" portion of a domain name. However, it is unclear whether this is actually the intended meaning of the term as used in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-10, 12-14, and 18-22 are rejected under 35 U.S.C. 102(e) as being

anticipated by Osaku et al. (U.S. Patent No. 6,061,738, hereinafter "Osaku").

In considering claim 1, as understood, Osaku discloses a method of generating

from a computer a request for a domain name, comprising the steps of:

Receiving on the computer a name associated with the domain name (col. 13,

line 25, "888"; col. 14, line 13, "yahoo://olympic");

Selecting a translation formula (col. 13, line 27, col. 14, lines 14-15, wherein a

translation "formula," as defined in Applicant's specification, consists of appending

characters to the inputted name, such that the "formula" taught by Osaku is the

"http://www.hatchusa.com/search.p?number=/" attached to the "888" or the

"http://search.com/bin/search?p=/" attached to the "yahoo://olympic");

Translating said received name with said translation formula to generate a

scheme-specific name (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully

formatted network access command </www.hatch.co.jp/> as the URL 266

corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the

result of its search of the YAHOO!® database as an HTML encoded document 286

[which will have a URL associated with the initially entered name]"); and

Generating, from the computer, a request for the domain name based upon said

scheme-specific name (col. 13, lines 32-39, wherein the computer sends a request to

the Hatch.Co.JP server for the domain name "www.hatch.co.jp").

In considering claim 2, Osaku further discloses receiving a translation identifier

("888", or "yahoo://" as described above), and selecting said translation formula based

at least in part on said received translation identifier (i.e. the "888" identifier selects the

"hatchusa" translation formula, and the "yahoo://" identifier selects the "yahoo"

translation formula).

In considering claim 3, Osaku further discloses that the translation identifier

comprises a geographical identifier (col. 18, lines 45-47, wherein the numerical name

can be a "zip code").

In considering claim 4, Osaku further discloses analyzing the received name for a

translation identifier (inherent, since the identifier is recognized and used to select the

formula).

In considering claim 5, Osaku further discloses that the translation formula

comprises at least one predetermined character and said step of translating the

received name includes adding at least one said predetermined character to said

received name (i.e. the formula for the "888" name adds the string of characters

"http://www.hatchusa.com/search.p?number=" to the received name; col. 13, lines 23-27).

In considering claim 6, Osaku further discloses that the translation formula comprises a string of characters to add to said received name (col. 13, lines 23-27, as described above).

In considering claim 7, Osaku further discloses that translating the received name includes adding the string of characters to the received name as a prefix (i.e. "888" becomes "http://www.hatchusa.com/search.p?number=888/"; col. 13, lines 25-27, which is then translated to www.hatch.co.jp).

In considering claim 8, Osaku further discloses that the step of translating the received name includes the step of adding the string of characters to the received name as a suffix (col. 14, lines 12-16, wherein the string "yahoo" is the received name, the string ".com/bin/search?p=olympic/" is the translation formula that is added as a suffix to the received name to translate the received name).

In considering claim 9, Osaku further discloses that translating the received name includes interleaving the string of characters with the received name (i.e. "yahoo://olympic" becomes "http://search.yahoo.com/bin/search?p=olympic/"; col. 14, lines 12-15).

In considering claim 10, Osaku further discloses that the translation formula removes at least one character from the received name (i.e. the "://" following "yahoo" in "yahoo://olympic" is removed to create "http://search.yahoo.com/bin/search?p=olympic/").

In considering claim 12, Osaku discloses a method of generating, from a computer, a request for a domain name, comprising the steps of:

Receiving on the computer a numeric entry of a name associated with the domain name (col. 13, line 25, "888");

Selecting a first translation formula (col. 13, line 27, wherein a translation "formula," as defined in Applicant's specification, consists of appending characters to the inputted name, such that the "formula" taught by Osaku is the "http://www.hatchusa.com/search.p?number=/" attached to the "888"); and

Translating said numeric entry to an alphanumeric entry using the first translation formula (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>"); and

Generating, from the computer, a request for the domain name based upon said alphanumeric entry (col. 13, lines 32-39, wherein the computer sends a request to the Hatch.Co.JP server for the domain name "www.hatch.co.jp").

In considering claim 13, Osaku further discloses receiving a translation identifier ("888"), and selecting said translation formula based at least in part on said received translation identifier (i.e. the "888" identifier selects the "hatchusa" translation formula).

In considering claim 14, Osaku further discloses receiving a translation identifier ("888" or "yahoo://Olympic"); selecting a second translation formula based at least in part on said translation identifier (if the "888" formula was selected the first time, now the "yahoo://Olympic" identifier could be selected the second time, or vice versa); and applying said second translation formula to the alphanumeric entry to result in a scheme-specific name (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the result of its search of the YAHOO!® database as an HTML encoded document 286 [which will have a URL associated with the initially entered name]")

In considering claim 18, Osaku discloses an apparatus for generating a request for a domain name, comprising:

A computer comprising an input device (col. 5, lines 37-46, "input device 14," "computer");

A browser operationally installed on said computer (col. 10, lines 20-25, "browser");

A translation module configured to:

Receive, on the computer, a name associated with the domain name from the

input device (col. 10, lines 20-50, describing the browser for entering the simplified

network address; col. 13, line 25, "888"; col. 14, line 13, "yahoo://olympic");

Select a translation formula (col. 13, line 27, col. 14, lines 14-15, wherein a

translation "formula," as defined in Applicant's specification, consists of appending

characters to the inputted name, such that the "formula" taught by Osaku is the

"http://www.hatchusa.com/search.p?number=/" attached to the "888" or the

"http://search.com/bin/search?p=/" attached to the "yahoo://olympic");

Translate said received name with said translation formula to generate a

scheme-specific name (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully

formatted network access command </www.hatch.co.jp/> as the URL 266

corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the

result of its search of the YAHOO!® database as an HTML encoded document 286

[which will have a URL associated with the initially entered name]"); and

Process the scheme-specific name through the browser to generate a request for

the domain name (col. 13, lines 32-39, wherein the computer sends a request to the

Hatch.Co.JP server for the domain name "www.hatch.co.jp").

In considering claim 19, Osaku discloses a computer readable medium bearing

instructions for generating a request for a domain name, the instructions being arranged

to cause one or more processors upon execution thereof to perform the steps of:

Receiving, on the computer a name associated with the domain name (col. 13, line 25, "888"; col. 14, line 13, "yahoo://olympic");

Selecting a translation formula (col. 13, line 27, col. 14, lines 14-15, wherein a translation "formula," as defined in Applicant's specification, consists of appending characters to the inputted name, such that the "formula" taught by Osaku is the "http://www.hatchusa.com/search.p?number=/" attached to the "888" or the "http://search.com/bin/search?p=/" attached to the "yahoo://olympic");

Translating said received name with said translation formula to generate a scheme-specific name (col. 13, lines 30-35, "the HatchUSA server 258 returns a fully formatted network access command </www.hatch.co.jp/> as the URL 266 corresponding to <888>"; col. 14, lines 25-29, "the database server 284 returns the result of its search of the YAHOO!® database as an HTML encoded document 286 [which will have a URL associated with the initially entered name]"); and

Generating a request for the domain name based upon said scheme-specific name (col. 13, lines 32-39, wherein the computer sends a request to the Hatch.Co.JP server for the domain name "www.hatch.co.jp").

In considering claims 20-22, Examiner has interpreted the term "top-level" domain name as meaning the entire web address (i.e. www.hatch.co.jp). Thus, according to this interpretation, Osaku further discloses that the scheme-specific name is a "top-level" domain name (col. 13, lines 31-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osaku,

in view of Wang et al. (U.S. Patent Application Publication No. 2002/0042736,

hereinafter "Wang").

In considering claim 11, Osaku does not disclose that the translation formula

converts the received name into a numeric entry. Osaku instead discloses converting

the received name into an alphanumeric entry (i.e. the www.hatch.co.jp domain name).

Nonetheless, converting a received name directly into a numerical, IP address (rather

than its associated domain name) is well known, as evidenced by Wang. In a similar

art, Wang discloses a system for converting numbers entered either via bar-code

readers or via a keyboard, directly into IP addresses, so that a user does not have to

enter a long textual URL in order to access a desired site (Abstract, ¶ 0030, 0031, 0034,

"direct translation of an IP address inherent in the UPC product information; see also,

Fig. 5). Therefore, given the teaching of Wang, a person having ordinary skill in the art

would have readily recognized the desirability and advantages of allowing the

translation system taught by Osaku convert the entered names directly into numerical IP

addresses, to allow for "immediate and automated access" to the desired web site (see

Wang, Abstract). Therefore, it would have been obvious for the system taught by

Osaku to convert numerical names into a numeric Web address, as taught by Wang.

Response to Arguments

In response to Applicant's remarks filed on February 18, 2003, the following

factual arguments are noted:

a.   Osaku does not advocate using a translation formula as that term is used within

the claims, as claimed in the independent claims.

b.   Osaku fails to teach that the scheme-specific name is only a top-level domain, as

claimed in claims 20-22.

c.   Buchholz does not disclose that the client and server both individually receive a

name associated with a domain name and generate a request for the domain name

based upon a scheme-specific name.

In considering (a), Applicant contends that Osaku does not advocate using a

translation formula as that term is used within the claims, as claimed in the independent

claims. Examiner respectfully disagrees. Notably, Applicant's specification describes a

translation "formula" as appending a certain set of characters to the inputted name (see

p 5, lines 15-16, "a translation formula may include appending of a string of characters

to the inputted address"). Thus, one proper way of interpreting the broad claim

language of a "translation formula" is in the manner described in Applicant's

specification. Osaku discloses the same sort of "translation formula" in col. 13, lines 25-

27 and col. 14, lines 12-15, wherein a string of characters is appended to an inputted

address string to formulate the scheme-specific name.

In considering (b), Applicant contends that Osaku fails to teach that the scheme-

specific name is only a top-level domain, as claimed in claims 20-22.   Examiner

respectfully disagrees. First, as discussed in the 35 USC 112 rejections above, the use

of a "top-level domain" is both new matter and is ambiguous as used in the claims. For

those reasons, and for the reasons given in the art rejections above, claims 20-22 are

rejected in view of Osaku.

In considering (c), Applicant contends that Buchholz does not disclose that the

client and server both individually receive a name associated with a domain name and

generate a request for the domain name based upon a scheme-specific name.

Examiner agrees, and has thus withdrawn the Buchholz rejections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

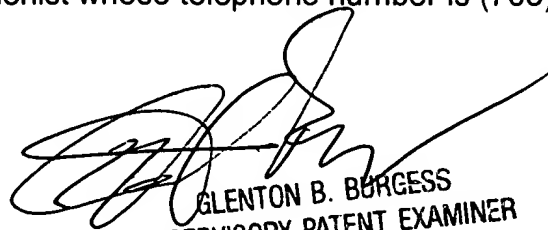than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Bradley Edelman whose telephone number is (703) 306-

3041. The examiner can normally be reached on Monday to Friday from 10:30 AM to

7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers

for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

BE
May 3, 2004